

**REMARKS**

**Claim Rejections**

Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Asakura (U.S. 5,995,372) in view of Anderson (U.S. 4,565,922).

**Drawings**

It is noted that no Patent Drawing Review (Form PTO-948) was received with the outstanding Office Action. Thus, Applicant must assume that the drawings are acceptable as filed.

**Claim Amendments**

By this Amendment, Applicant has amended claim 3 of this application. It is believed that the amended claim specifically sets forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and defines subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The primary reference to Asakura teaches a card-type electronic device having a metal plate (3), a printed circuit board (2), printed patterns (4a) located on one side of the printed circuit board, an insulating layer (2b), and a frame (1). The printed patterns (4a) and the insulating layer (2b) are located on a common side of the printed circuit board (2). The metal plate (3) and the printed patterns (4a) are located on opposite sides of the printed circuit board.

The present invention uses a PC board as a lower case, thereby replacing the lower case, and encloses passive parts with a plastic injection molding technique to leave a space for placing ICs. Therefore, it is not necessary to choose a particular specification for the ICs, which implicitly reduce a cost, and the ICs can be produced automatically with an SMT (Surface Mounting Technology).

The upper case of present invention is a body in a shape of block which is made integrally by an injection molding technique to enhance a mechanical strength of the case body. In Asakura, a circuit board is sandwiched between an upper and

lower cases, whereas in the present invention, two kinds of different materials are assembled.

Asakura uses a metal plate (3) to reinforce a strength of memory card. However, the metal plate (3) is indented inward to prevent from a short-circuiting caused by a careless operation of user, and not to install passive parts such as ICs.

Asakura does not teach the first contact terminal is located on the top of the circuit board between the case and the first end of the circuit board; nor does Asakura teach an end of the case being spaced apart from the first end of the circuit board a distance greater than a length of the at least two contact terminals.

The secondary reference to Anderson teaches a key card apparatus having a card (1) having a first surface (2) having parallel contacts (20) and a second surface (4) having parallel contacts (40).

Anderson does not teach the first contact terminal is located on the top of the circuit board between the case and the first end of the circuit board; nor does Anderson teach an end of the case being spaced apart from the first end of the circuit board a distance greater than a length of the at least two contact terminals.

Even if the teachings of Asakura and Anderson were combined, as suggested by the Examiner, the resultant combination does not suggest: the first contact terminal is located on the top of the circuit board between the case and the first end of the circuit board; nor does the combination suggest an end of the case being spaced apart from the first end of the circuit board a distance greater than a length of the at least two contact terminals.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a

piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Asakura or Anderson that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Asakura nor Anderson disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's amended claims.

**Summary**

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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